

## **REMARKS**

In the January 19, 2010 Office Action, the specification was objected to and claims 1-14 stand rejected in view of prior art. Claims 1-14 also were rejected for allegedly failing to comply with the written description requirement. No other objections or rejections were made in the Office Action.

### ***Status of Claims and Amendments***

In response to the January 19, 2010 Office Action, Applicant has amended claims 5, 9 and 14 as indicated above. Also, Applicant has cancelled claims 1-4. Thus, claims 5-14 are pending, with claims 5 and 9 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

### ***Specification/Abstract***

In paragraphs 3 and 4 of the Office Action, (1) the specification was objected to because the Amendment filed on October 30, 2009 allegedly introduced new matter, and (2) the specification was also objected to for failing to provide proper antecedent basis for the claimed subject matter.

In response to objection (1), Applicant has amended the specification and Abstract to change the term “cassettes” to - - compartments - - for the reasons that follow. The English translation (filed July 11, 2006) of International Patent Application No. PCT/JP2004/011292 utilized the term “cell parts”. However, the original application (i.e., International Patent Application No. PCT/JP2004/011292, written in Japanese) uses two different Japanese words for “cells”, one meaning “cells - compartments” and one meaning to “cells - biological”. The Japanese word for “cells”, meaning “compartments”, was translated to “cell parts” in July 11, 2006 English translation. Thus, the July 11, 2006 English translation of International Patent Application No. PCT/JP2004/011292 included a translation error or at least an inaccuracy, apparently to avoid using the same English word, “cells”, for two different things in the translation. Note the original claims refer to “cell parts” and “cells”, and if “cells” were used for both, the claims would be confusing. In any case, upon review the original Japanese of

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International Patent Application No. PCT/JP2004/011292 by a bilingual Japanese/English person, it is clear that the application as originally filed supports the change of the term “cell parts” (in the July 11, 2006 translation) or “cells” (in International Patent Application No. PCT/JP2004/011292) to - - compartments - -. Incidentally, the July 11, 2006 translation is not the U.S. application as originally filed under the RCT rules. Rather, International Patent Application No. PCT/JP2004/011292 (in Japanese) is the application as originally filed. Thus, it is appropriate and acceptable for Applicant to correct the English translation when needed, such as in this case. In any event, the changes made to the specification now make the English specification more accurate as compared to the (Japanese in) International Patent Application No. PCT/JP2004/011292, and thus, no new matter is entered by this change.

In response to objection (2), Applicant has amended claims 5 and 9 to use the language that already existed on lines 5-6 of page 2 of the July 11, 2006 English translation of International Patent Application No. PCT/JP2004/011292. In view of these Amendments to claims 5 and 9 and the disclosure on lines 5-6 of page 2 of the July 11, 2006 English translation of International Patent Application No. PCT/JP2004/011292, Applicant respectfully asserts that the specification provides proper antecedent basis for the claim terminology, as now amended. Incidentally, antecedent basis for claim terminology in the specification does not mean the language of the claims must appear verbatim in the specification. In any event, Applicants have amended claims 5 and 9 to overcome this objection and advance prosecution in this case.

Based on the above Amendments and comments, withdrawal of objections (1) and (2) is respectfully requested.

#### *Claim Rejections - 35 U.S.C. §112*

In paragraph 6 of the Office Action, claims 1-14 were rejected under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. In response, Applicant has amended claims 5 and 9 to use the language that already existed in the specification. See lines 5-6 of page 2. Also, Applicant notes that the meaning of “ambient temperature” is generally well known in the art. Applicant believes that the claims now comply with 35 U.S.C. §112, first paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

***Rejections - 35 U.S.C. § 102***

In paragraph 8 of the Office Action, claims 1, 5 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0072112 (Atwood). In response, Applicants have cancelled claims 1-4 and amended claims 5 and 9 to place these claims in independent form. Also, independent claims 5 and 9 have been amended to overcome the rejection under 35 U.S.C. §112, first paragraph, as explained above. Finally, independent claim 9 has been amended to clarify that “said calculation unit calculates a second target value based on said target value and calibration data in accordance with said ambient temperature”. This rejection is respectfully traversed as explained below.

Independent claim 5 now requires, *inter alia*, a plurality of compartments holding microorganisms or cells; a heater and a cooling unit making control of temperatures inside said compartments; a thermometer measuring an ambient temperature of an environment in which the device is installed; a storage unit storing calibration data; and a control unit setting a target value for said temperatures inside said compartments, and controlling said heater and said cooling unit with a second target value that is obtained based on said target value and said calibration data in accordance with said ambient temperature such that control of temperatures inside said compartments is corrected by using said ambient temperature measured by said thermometer.

Independent claim 5 now requires, *inter alia*, a plurality of compartments holding microorganisms or cells; a heater and a cooling unit making control of temperatures inside said compartments; a thermometer measuring an ambient temperature of an environment in which the device is installed; a control unit setting a target value for said temperatures inside said compartments; and a calculation unit, wherein said calculation unit calculates a second target value based on said target value and calibration data in accordance with said ambient temperature, and said control unit controls said heater and said cooling unit with said second target value such that control of temperatures inside said compartments is corrected by using said ambient temperature measured by said thermometer.

Contrary to the assertions of the Office Action, these structures are *not* disclosed or suggested by the Atwood publication. First, the ambient temperature measured by the thermometer sensor 56 in the Atwood publication is an internal ambient air temperature

within the housing of the system (see paragraph [0110] of the Atwood publication), ***not an ambient temperature of an environment in which the device is installed***, as now required by independent claims 5 and 9. Second, in the Atwood publication, the user specifies a sequence of target temperatures (see paragraph [0110] of the Atwood publication). However, none of these *target temperatures* in the Atwood publication are ***obtained based on said target value and said calibration data in accordance with said ambient temperature*** as required by independent claim 5, or ***calculated based on said target value and calibration data in accordance with said ambient temperature*** as required by independent claim 9. In other words, the target temperatures referred to in the Atwood publication are ***user specified***, and thus, are not obtained or calculated as required by independent claims 5 and 9.

It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicant respectfully submits that independent claims 5 and 9, as now amended, are not anticipated by the Atwood publication. Accordingly, withdrawal of this rejection is respectfully requested.

#### ***Rejections - 35 U.S.C. § 103***

In paragraphs 9-13 (pages 5-15) of the Office Action, claims 2-4, 6-8 and 10-14 stand rejected under 35 U.S.C. §103(a) as follows:

- (1) Claims 2, 3, 6, 7, 10 and 11 are rejected as being unpatentable over the Atwood publication in view of U.S. Patent No. 5,802,856 (Schaper);
- (2) Claims 4, 8, 12 and 13 are rejected as being unpatentable over the Atwood publication in view of the Schaper patent and further in view of U.S. Patent No. 6,626,236 (Bandoh); and
- (3) Claim 14 is rejected as being unpatentable over
  - (a) the Atwood publication as applied to claims 1, 5 and 9, in view of Japanese Patent Publication No. 2003-235544 (Haga),
  - (b) the Atwood publication in view of the Schaper patent as applied to claims 2, 3, 6, 7, 10 and 11, in view of Japanese Patent Publication No. 2003-235544 (Haga), and

(c) the Atwood publication in view of the Schaper and Bandoh patents as applied to claims 4, 8, 12 and 13, and further in view of the Haga publication.

In response, Applicants have cancelled claims 1-4 and amended claims 5 and 9 to place these claims in independent form. Also, independent claims 5 and 9 have been amended to overcome the rejection under 35 U.S.C. §112, first paragraph, as explained above. Finally, independent claim 9 has been amended to clarify that “said calculation unit calculates a second target value based on said target value and calibration data in accordance with said ambient temperature”. These rejections are respectfully traversed as explained below.

Specifically, the Atwood publication fails to disclose or suggest the features of independent claims 5 and 9, as now amended, as explained above. The remaining references fail to account for the deficiencies of the Atwood publication with respect to independent claims 5 and 9. More specifically, the remaining references relied upon in rejections (1) to (3), the Schaper patent, the Bandoh patent and the Haga publication, do not disclose or suggest using *an ambient temperature of an environment in which the device is installed*, as now required by independent claims 5 and 9; using a second target value *obtained based on said target value and said calibration data in accordance with said ambient temperature* as required by independent claim 5; or using a second target value *calculated based on said target value and calibration data in accordance with said ambient temperature* as required by independent claim 9. Since none of the references used in these rejections discloses these unique arrangements, any hypothetical device created by somehow combining these references cannot include these unique arrangements of independent claims 5 and 9, as now amended. Therefore, no combination of the references relied upon in rejections (1) to (3) can disclose or suggest the arrangements of dependent claims 6-8 and 10-14, which depend from independent claims 5 and 9. Accordingly, withdrawal of rejections (1) to (3) of this section is respectfully requested.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that

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obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some “apparent reason to combine the known elements in the fashion claimed.” Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents, and then further modifying a hypothetical device created by such a hypothetical combination, to create Applicant’s unique arrangements of independent claims 5 and 9, as now amended.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 5-14 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,

/Patrick A. Hilsmier/  
Patrick A. Hilsmier  
Reg. No. 46,034

GLOBAL IP COUNSELORS, LLP  
1233 Twentieth Street, NW, Suite 700  
Washington, DC 20036  
(202)-293-0444

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